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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,592	02/15/2005	Francesco Bonfanti	11157US	6558
36608 7590 08/18/2008 GUIDRUN E. HUCKETT DRAUDT SCHUBERTSTR. 15A WUPPERTAL, 42289 GERMANY				
EXAMINER				
HIGGINS, GERARD T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
08/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,592

Applicant(s)

BONFANTI ET AL.

Examiner

GERARD T. HIGGINS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The response filed 12/09/2007 has been entered. The Examiner recognizes that claims 12-19 were cancelled in the preliminary amendment filed 08/03/2005, and therefore the Examiner has vitiated the rejections from the office action mailed 11/15/2007 and has subsequently set forth a new office action on the merits.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other

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information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the reference EP 0781634 cited in the Search Report has not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification

4. The disclosure is objected to because of the following informalities:
 - a. On page 4, line 9 "be can arranged," is awkward
 - b. On page 3, lines 20 and 22 to "lines that extend perpendicularly" and "perpendicularly to said first direction," which are both awkward.Appropriate correction is required.

Claim Objections

5. Claims 25 and 29 are objected to because of the following informalities: the same rationale seen in section 4b above. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 20-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 20-26, the term "film compound" is indefinite. A compound is a term especially used with relation to substance comprising chemical elements bonded together.

In claims 23 and 28, the term "neighboring ones" is unclear because it is not clear what is meant by neighboring or which webs would be considered neighboring.

In claims 24 and 27 there is the limitation "several of the at least one dividing line extending parallel to one another." This is an extremely confusing phraseology and the Examiner suggests using the language from page 3, lines 10-18. Specifically, one cannot have one dividing line parallel to itself, which renders this claim indefinite.

In claims 25 and 29 there is the limitation "several of the at least one dividing line extending [perpendicular] to one another." This is an extremely confusing phraseology and the Examiner suggests using the language from page 3, lines 19-26. Specifically, one cannot have one dividing line perpendicular to itself, which renders this claim indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 20, 21, 23, 24, 26-28, 30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Grawey et al. (5,055,734).

With regard to claims 20, 24, and 27, Grawey et al. disclose the devices of Figures 1 and 2.

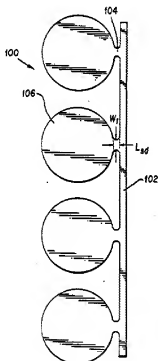


FIG. 1

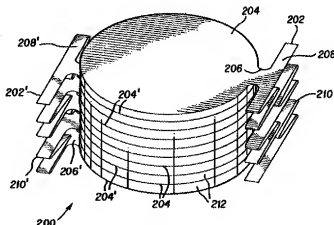


FIG. 2

The film of Figure 1 has a dividing line that stretches vertically in between the parts **102** and **106**, which is interrupted by the webs **104**. It is clear from the figure that the webs have a width that is, on average, less than an average spacing between adjacent webs. The parallel dividing lines to which applicants are referring to in claims 24 and 27 would fall in between the parts **106** of Grawey et al., i.e. in the x-direction in Figure 1 above

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(left-to-right on the paper). Therefore, the mirror plane spoken of in applicants' claim 27 would be in the y-direction (up-and-down) and it clear that performing a reflection about said mirror plane of the device of Figure 1 would generate a device that would not be superimposable. The device of Figure 2 anticipates the limitation of claim 20. Two of the same devices of Figure 1 of Grawey et al. are arranged such that the webs are not superimposed in alternating layers.

With regard to claim 21, it is clear from Figure 2 that the alternating layers are arranged to differ by 180° of rotation.

With regard to claims 23 and 28, it is clear from Figure 1 and 2 that the width of all the webs, respectively, is less than the spacing to said adjacent webs.

With regard to claims 26 and 30, it is clear that a 180° rotation performed on the device of Figure 1 would generate a device that would not be superimposable with the original device.

With regard to claim 32, the device of Grawey et al. is designed as a "multiple electrode conductor for piezoelectric solid state motor stacks" (col. 1, lines 9-11). Cathodes or anodes are electrodes and therefore this anticipates applicants' claim 32.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 20, 21, and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michalik (4,951,967).

With regard to applicants' claims 20 and 23, Michalik teaches the perforated sheet of Figures 3 and 8. Both Figures contain a dividing line **36** that is interrupted by a series of webs **39** and **63**. Michalik discloses the width of the webs "a" as "about 0.5 to 3 mm" at col. 4, line 9, further they refer to the webs as being "small" at col. 4, line 61, and clearly the drawings reflect the distance "a" as being smaller than the width of the cut section **35**; however, with respect to applicants' claims 20 and 23 they silent with respect to the specific distances of the cut section **35** compared to the webs **39**. The Examiner deems from the dimensions of the drawings that the webs have a width that is, on average, less than an average spacing between two adjacently positioned webs, and also that the width of all the webs, respectively, is less than a spacing of the webs to a neighboring one of the webs, respectively.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the dimensions of the cutting blades and the spacing in between adjacent cutting blades to arrive at a sheet having web widths appropriate for applicants' intended use such that the webs had a width that is, on average, less than an average spacing between two adjacently positioned ones, and also where the width of all the webs, respectively, is less than a spacing of the webs to a neighboring one of the webs, respectively. The technique of die cutting is well known in the art and would have generated predictable results to one having ordinary skill in

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the art. The motivation to incorporate the limitations of this claim would be to have a device that would have a higher strength and would not be easily detached at the web sections.

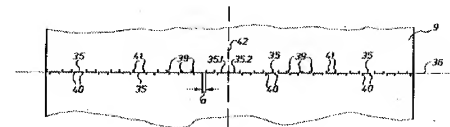


Fig. 3

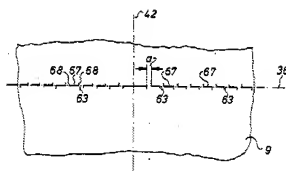


Fig. 8

The Examiner deems the limitation requiring at least two stamped films to be a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). If two sheets of the type of Figure 8 were arranged in a staggered arrangement, it would not produce a new or unexpected result.

With regard to claim 21, if one of the two sheets were staggered from the other sheet and then rotated by 180° about the central axis located on the line 36, it would

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result in an article that renders obvious applicants' claim 21. There are a limited number of arrangements for this article and one would be providing the two sheets at a rotation of 180° about the central axis to each other.

With regard to claims 24 and 27, Michalik teaches or renders obvious all the limitations of applicants' claims 20 and 23 as seen above; however, with regard to applicants' claim 24 Michalik fails to specifically teach a film with multiple cuts in the y-z plane, wherein the webs of said y-z plane would not be superimposable after a reflection about the x-z mirror plane. In this instance the Examiner deems the cuts along the line **36** to be equivalent to the aforementioned cuts by applicants along said y-z plane. The Examiner further notes that if one performs the mirror plane reflection about the line **42**, a plane perpendicular to the cuts along the line **36**, seen in Figure 3 of Michalik, the perforated sheet overall would not be superimposable. Since claim 27 incorporates all of the limitations of applicants' claims 20 and 24, clearly claim 27 is also taught by Michalik.

Since it is a well-known skill in the art to machine perforating blades to different sizes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have perforating teeth with a variety of widths such that one would arrive at a sheet that would not have superimposable webs in order to increase the strength of superimposed sheets.

With regard to applicants' claims 25 and 29, Michalik fails to specifically teach a film with at least one cut in the x-z plane, wherein the webs of said x-z plane would not be superimposable after a reflection about the y-z mirror plane. In this instance the

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Examiner deems the cut(s) along the line **42** to be equivalent to the aforementioned cut(s) by applicants along said x-z plane. The Examiner further notes that if one performs a mirror plane reflection on line **36** in either the embodiment of Figures 3 or 8, the resultant perforated sheets overall are not superimposable.

Similar to the logic used above for applicants' claims 24 and 27, it is a well-known skill in the art to machine perforating blades to different sizes and shapes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have perforating teeth with a variety of widths such that one would arrive at a sheet that would not have superimposable webs. The motivation to incorporate the limitations of this claim would be to have a device that would have a higher strength and would not be easily detached at the web sections.

With regard to applicants' claim 26 and 30, if one performs the 180° rotation about the central axis at the intersection of lines **42** and **36** of Figure 8, the resultant perforated sheets overall would not be superimposable; however, Michalik fails to teach a film having webs that were not superimposable after performing a 180° rotation about a central axis.

Again, since it is a well-known skill in the art to machine perforating blades to different sizes and shapes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have perforating teeth with a variety of widths such that one would arrive at a sheet that would not have superimposable webs. The motivation to incorporate the limitations of this claim would be to have a device that would have a higher strength and would not be easily detached at the web sections.

With respect to claim 28, Michalik is silent with respect to the specific distances of the cut section **35** compared to the webs **39**. The Examiner deems from the dimensions of the drawings that the webs have a width that is, on average, less than an average spacing between two adjacently positioned webs, and also that the width of all the webs, respectively, is less than a spacing of the webs to a neighboring one of the webs, respectively.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the dimensions of the cutting blades and the spacing in between adjacent cutting blades to arrive at a sheet having web widths appropriate for applicants' intended use such that the webs had a width that is, on average, less than an average spacing between two adjacently positioned ones, and also where the width of all the webs, respectively, is less than a spacing of the webs to a neighboring one of the webs, respectively. The technique of die cutting is well known in the art and would have generated predictable results to one having ordinary skill in the art. The motivation to incorporate the limitations of this claim would be to have a device that would have a higher strength and would not be easily detached at the web sections.

12. Claims 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grawey et al. (5,055,734), in view of Bechtel et al. (6,402,328), as applied to claims 20 and 27, respectively.

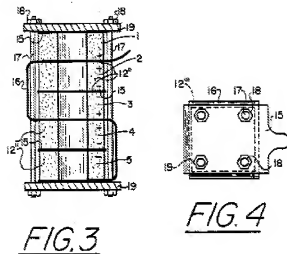
Grawey et al. disclose the limitations of applicants' claims 20 and 27 as seen in section 8 above. They also disclose the use of the aforementioned devices as a transducer, more specifically an actuator; however, they fail to specifically disclose the use of said devices as either an electrochemical or electrochromic device.

Bechtel et al. disclose the use of transducers in the field of electrochromic automatic dimming rearview mirrors (col.2, lines 22-24).

Both Grawey et al. and Bechtel et al. are drawn to transducers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the known device of Grawey et al. in an electrochromic device such as the one described by Bechtel et al. The combined device would have produced predictable results to one having ordinary skill in the art.

13. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grawey et al. (5,055,734) in view of Abbott (4,499,566), as applied to claim 27.

Grawey et al. disclose all the limitations of applicants' claim 27 in section 8 above; however, it fails to disclose positioning holes. Abbott discloses the transducer stack seen in Figures 3 and 4.



The transducer stack comprises 2-4 positioning rods **17** (col. 4, lines 3-9), which obviously must have positioning holes for the positioning rod to go through said transducer stack.

Both Grawey et al. and Abbott are drawn to transducer assemblies; therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the known prior art element of positioning holes in the transducer assembly of Grawey et al. Each element would have performed the same function as it did separately, and the results of this combination would produce predictable results to one having ordinary skill in the art. The motivation for doing so would be to provide a stable structure that would not wear down over time.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is

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(571)270-3467. The examiner can normally be reached on M-F 7:30am-5pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins, Ph.D.
Examiner
Art Unit 1794

/Gerard T Higgins, Ph.D./
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794